

REMARKS

Claims 1-20 are pending in the present application. No amendments have been made to the claims. Applicant respectfully request reconsideration of the subject application. This Amendment is submitted in response to the Office Action dated July 10, 2006.

Status Of The Specification

Applicant draws Examiner's attention to the preliminary amendment filed on May 02, 2001 in which Applicant amended the specification to include a reference to related applications. Applicant has now amended the paragraph to precede with the header: "Cross-Reference to Related Applications". Applicant respectfully requests entry of the amendment to the specification and withdrawal of any objection to the arrangement of the specification.

Rejection of Claims 1-20

Claims 1-20 currently stand rejected. Claims 1, 3 and 11 are newly rejected under 35 U.S.C. § 103(a) (hereinafter, "Section 103(a)") as being unpatentable over Aravamudan et al. (U.S. Pat. No. 6,301,609, hereinafter, "Aravamudan") in view of Ilsen et al., (U.S. Patent No. 6,757,898, hereinafter "Ilsen") and in view of Cooper et al., (U.S. Patent No. 5,757,908, hereinafter, "Cooper").

Claim 2 is newly rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and Cooper and further in view of Gerace (U.S. Pat. No. 5,848,396, hereinafter, "Gerace").

Claim 4 is newly rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and Cooper and further in view of Kraft (U.S. Pat. No. 6,309,305, hereinafter, "Kraft"). Claims 5 and 6 are rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and Cooper and further in view of and McDowell (U.S. Patent Publication No. 2001/0034224, hereinafter, "McDowell").

Claims 7, 9, 10, 13, 17 and 19 are newly rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and Cooper and further in view of Patil (U.S. Pat. No. 6,625,460, hereinafter, "Patil").

Claim 8 is newly rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and Cooper and in further view of Smith et al. (U.S. Pat. No. 6,333,973, hereinafter, "Smith").

Claim 12 is newly rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen, Cooper and Patil and further in view of Gerace.

Claim 14 is newly rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen and Patil and further in view of Kraft.

Claims 15 and 16 are newly rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen, Cooper and Patil and further in view of McDowell.

Claims 18 and 20 are newly rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen, Cooper and Patil and further in view of Smith.

Applicant respectfully traverses all rejections and requests reconsideration for all pending claims in light of the remarks below.

Applicant respectfully submits that claim 1 is novel and nonobvious over Aravamudan in light of Ilsen and Cooper.

Applicant respectfully disagrees with Examiner's assumptions and interpretations of the Ilsen patent. Ilsen discloses validation techniques to determine an identity of a user based on the user's existing information in a database. Ilsen teaches validating a "login" attempt based on a sign-up form. (Ilsen, Col. 30, lines 9-21). However, Applicant's claim 1 of "determining whether the initial receiving was associated with a request to register the prospective user from someone other than a prospective user" is not taught by validating a user's sign-up form or login attempt. It is certain that a user in Ilsen may attempt to match a record in the repository or log in but for reasons such as forgetting their proper email address, password, username, or even mistyping information, is rejected or denied access. Therefore, just because there is a non-match does not show someone other than the user has requested to register the prospective user. The user in Ilsen may have simply invalidly entered information. As such, Examiner's assertion that a non-match in Ilsen equates to a determination that a request has been made by "someone other than the prospective user" is not disclosed or suggested.

Moreover, contrary to Examiner's assertion, Ilsen does not "invite registration of the prospective user" as in Applicant's claim 1. Ilsen invites "login" of an already registered user and is therefore confirming registration (Ilsen, col. 30, lines 22-30). Applicant claims an invitation to register, which is not disclosed or suggested by an invitation to "login". Ilsen teaches the sign-up form is where registration takes place, and it is only after a match is made and registration has been completed, that instructions for first time "login" is sent. (Col. 30,

lines 22-26). Importantly, Examiner has already confirmed in the Office Action of October 24, 2005, page 2, point 4, that “Regarding Applicant’s argument that ‘inviting registration’ is not taught, Examiner agrees”. Ilsen therefore fails to provide the required element of claim 1.

It is Improper to Use Cooper to Reject Applicant’s Claims

Applicant believes the Cooper reference is a non-analogous art and was improperly used in this rejection. Cooper shows a reference from a field for securing access to software objects, for temporarily encrypting and restricting access to software objects, a very different field from the present invention of registering a user in an IM system. Cooper is concerned with a wholly different field of endeavor, based on a different function, with a different purpose, provided to solve a different problem than Applicant’s invention. Cooper is concerned with piracy and unauthorized usage of software, and providing a user a trial period of enabled usage to determine if the software is desired. This is in no manner related to the objects of Applicant’s invention which is concerned with quick, easy and efficient registration to an IM system to those interested in joining an IM community, by automatically allocating or assigning unique identifiers to prospective users of the system. Contrary to Examiner’s assertion in the Office Action on page 5, Applicant is not concerned with a “trial period of usage for reviewing of software”. In order to rely on a reference as basis for a rejection of an invention, the reference must either be in the field of applicant’s endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. (*See* MPEP 2141.01(a)). Applicant submits that since Cooper is from a very different field than Applicant’s invention, and is directed to a different problem, it should be withdrawn as prior art.

The Novel Subject Matter of Claim 1 is Unobvious Over Cooper

Applicant submits that even if Cooper were usable in a rejection of Applicant's claims, claims 1 (and 11) recite clearly novel and non-obvious subject matter over Cooper. Applicant's claim 1 recites that "in response to said determining step, tentatively registering an account for said prospective user by storing the matched unique identifier and client specific access address with said IM server under the unique identifier". Cooper discloses allowing a user "a temporary trial period without subjecting the software product to unnecessary risks of piracy or unauthorized utilization beyond the trial interval...During the trial mode of operation, the software object is temporarily enabled... This facilitates browsing operations..." (Col. 2, lines 31-34, lines 49-51 and lines 63).

Cooper does not disclose "tentatively registering an account", as recited in claim 1, but rather discloses providing "tentative usage". Nowhere does Cooper even suggest "tentatively registering an account". Cooper provides fully enabled use of a software and allowing for browsing operations during a trial mode. Applicant's claim of "tentatively registering an account" and "in response to determining whether the initial receiving was associated with a request to register the prospective user from someone other than the prospective user" (emphasis added) is just not provided by Cooper. As such, Cooper fails to teach or suggest such limitation in claim 1.

Therefore, Ilsen and Cooper fail to disclose or suggest ALL claim limitations as required to establish a prima facie case of obviousness. Since Claims 1 and 11 are in a field that is not analogous to that of Cooper, and since these claims recite novel and unobvious

features over Aravamudan in light of Ilsen and Cooper, Applicant submits that these claims merit allowance. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 11 under Section 103(a).

For at least these reasons, it respectfully submitted that claim 1 and its dependent claims are novel and nonobvious over Aravamudan in view of Ilsen and Cooper. Claims 1 and 11 and their dependent claims are also allowable over Aravamudan in view of Ilsen and Cooper for similar reasons.

Request For Withdrawal Of Finality Of Office Action

Due to Applicant's belief of the non-analogous nature of the Cooper reference as discussed above, Applicant respectfully requests reconsideration of the finality of the present office action for this application.

Conditional Request For Constructive Assistance

Applicant has made a diligent effort to previously amend the claims of this application so that they define novel and unobvious structure. If, for any reason, the Examiner believes that the claims of this application are not yet in full condition for allowance, applicant respectfully requests his constructive assistance and suggestions pursuant to the spirit of MPEP § 2173.02 and § 707.07(j). This will enable the undersigned to place this application in fully allowable condition as soon as possible and without the need for further proceedings. The Examiner is authorized to make any needed minor corrections or changes.

Conclusion

The above-discussed remarks are believed to place the present Application in condition for allowance. Should the Examiner have any questions regarding the above amendments, the Examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

Date: October 10, 2006

/Juneko Jackson/

Otto O. Lee (Reg. No.: 37,871)

Juneko Jackson (Reg. No.: 48,870)

Marie G. Capuyan (Reg. No.: 52,695)

Intellectual Property Law Group LLP

Attorneys for Applicant

Atty Docket No.: YSAP.CHIKKA.PT2
Contact No.: 408-286-8933